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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,661	01/10/2001	Thomas Magid	9726-2	7492

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EXAMINER	
THEIN, MARIA TERESA T	
ART UNIT	**PAPER NUMBER**
3627	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/757,661	MAGID, THOMAS	
	Examiner	Art Unit	
	Marissa Thein	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,7,9-13,15,16,18-32 and 34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-7, 9-13, 15-16, 18-32, and 34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

Applicant's "Amendment" filed on March 17, 2006 has been considered with the following effect.

Applicant's response by virtue of amendment to claims 1-4, 6-9, 21-22, 26-27, 31, and 34 has overcome the Examiner's objection.

Claims 1-2, 6, 8-11, 18, 20, 22, 26-29, 31 and 34 are amended. Claims 8, 17, and 33 are cancelled. Claims 1-4, 6-7, 9-13, 15-16, 18-32, and 34 are pending in this application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-20, 25, 30 are rejected under 35 U.S.C. 101 because it fails to recite ***computer readable medium***. The claims are directed to a program. Giving the term its broadest reasonable interpretation, the claims are directed to a program per-se and a program instruction. Accordingly, the claim fails to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106. For example, Applicant can rewrite the claim as "A computer program product in a computer readable medium...".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-7, 9-13, 15-16, 18-32, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete of errors which causes the scope of the claims to be ambiguous. The Applicant must reread and edit the claims and clearly amend the claims. For example claim 1, lines 12-13, the recitation of "receiving from a seller the input of and presenting" can be rewritten as "inputting, by the seller, a first level of information disclosure".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-7, 9-12, 15-30, and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,933,498 to Schneck et al.

Regarding claims 1, 10, and 19, Schneck discloses a method, a computer program, a computerized medium comprising a program therein instructed for, interesting and retaining at least one qualified purchaser or licensee of a patent, the program having machine readable program code for providing the purchaser to access to varying levels of information disclosure relating to the patent based on levels of interest and the machine readable program code protecting the levels of information disclosure, wherein the program code when executed causes a computer to perform the steps of : (col. 6, lines 51-58; col. 7, lines 1-7; col. 7, lines 27-29; col. 10, lines 20-26;

col. 15, lines 1-8; col. 15, lines 44-50; col. 22, lines 55-58; col. 29, lines 34-36; col. 34, lines 37-39);

- receiving from a seller (data distributor) the input of and presenting a first level of information disclosure that is confidential and secure to a prospective purchaser and requesting a first response, said first response comprising a fulfillment of a first demand by the purchaser (see at least col. 1, lines 32-35col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 34, lines 43-48):
- accepting the fulfillment by the purchaser of the first demand (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59);
- receiving from the seller the input of and presenting a second level of disclosure that is more confidential and more secure than the first level of disclosures relating to said product or method that is more confidential and is more secure than the first level of disclosure to the purchaser and requesting a second response, the second response comprising a fulfillment of a second demand by the purchaser (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 34, lines 43-48)
- accepting the fulfillment by the purchaser of the second demand (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59);
- optionally receiving and presenting an offer by one of the seller or purchaser and receiving and presenting an acceptance by the other of the seller or

purchaser to enter into a contract relative to the patent (see at least col. 6, lines 51-58; col. 13, lines 7-9col. 22, lines 5-61)

Regarding claims 2, 6, 9, 11, 15, 18, 20, and 22, 24, Schneck discloses seller presents additional levels of disclosure and inputting requests for additional responses; the successive level of information disclosure presenting has associated therewith and increasing level of confidentiality and security; connecting to a network core site that offers peripheral services relating to the marketing or exchange of patents offered (see at least col. 16, lines 39-42; col. 20, lines 9-37; col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 22, lines 5-42; col. 34, lines 37-39).

Regarding claims 3 and 12, Schneck discloses the contract is a licensing agreement (col. 29, lines 34-40).

Regarding claims 7 and 16, Schneck discloses the demands comprise compensation, comprising one or more of money, certification authentication or agreements (col. 22, lines 5-12; col. 22, lines 21-46).

Regarding claims 21, 23, 25-30, and 32, Schneck discloses the first and second responses are requested by the purchaser and comprise fulfillment of a first and second demand by the seller, and the seller fulfills the first and second demands; the purchaser inputting a request for response from the seller comprising fulfillment of a demand by the seller prior to presentation of each level of disclosure; and first level of disclosure is unsecure (see at least col. 9, lines 55-59; col. 16, lines 39-42; col. 20, lines 9-37; col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 22, lines 5-42).

Regarding claim 34, Schneck discloses a network cores site that is accessible via an Internet (col. 15, lines 1-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 13, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,933,498 to Schneck et al in view of U.S. Patent No. 5,991876 to Johnson et al.

Regarding claims 4 and 13, Schneck substantially discloses the claimed invention, however, it does not explicitly disclose the contract is an assignment of rights. Schneck discloses the purchase of a license, such as intellectual property (col. 10, lines 27-28; col. 29, lines 34-35). The intellectual property can be trade secret col. 34, lines 37-39).;

Johnson, on the other hand, teaches the contract is an assignment of rights (Figure 3; col. 11, lines 4-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Schneck, to include the contract is an assignment of rights, as taught by Johnson, in order to manage rights to authorized users (Johnson, col. 1, line 7).

Regarding claim 31, Schneck substantially discloses the claimed invention, however, it does not explicitly disclose the contract permits the purchaser to make multiple copies to the tangible item or perform the method multiple times. Schneck discloses the purchase of a license, such as intellectual property (col. 10, lines 27-28; col. 29, lines 34-35). The intellectual property can be trade secret col. 34, lines 37-39).

Johnson, on the other hand, teaches the contract permits the purchaser to make multiple copies to the tangible item or perform the method multiple times (col. 2, lines 4-21; col. 3, lines 7-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Schneck, to include the contract permits the purchaser to make multiple copies to the tangible item or perform the method multiple times, as taught by Johnson, in order to manage rights to authorized users (Johnson, col. 1, line 7).

Response to Arguments

Applicant's arguments filed March 17, 2006have been fully considered but they are not persuasive.

Applicant's remark that "Schneck does not anticipate the claims under 35 USC 102 (b) because the data in Schneck is not protecting information relating to a patent".

The Examiner notes that Schneck discloses intellectual property (col. 10, lines 27-28), which encompasses patents. Furthermore, Schneck discloses "the protection offered by the present invention may be used to enforce rights in intellectual property whether the protection at law is categorize as copyright, trade secret, contract or

something else" (col. 34, lines 37-39). In the Collins Dictionary of Law (1996) "intellectual property" is defined as a conveniently term to describe various parts of the law that have the effect of protecting products of the imagination and intellect. It covers, generally, copyright, patents, designs, registered designs, trademarks, know-how and passing off. Therefore, intellectual property is considered and includes patents.

Applicant's remark that "Schneck is not directed to protection of information disclosure relating to a patent. Johnson does no make up for this deficiency because Johnson does not protect information disclosure relating to a patent".

The Examiner draws Applicant's attention to the discussion above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot
May 30, 2006

STEVE B. MCALLISTER
PRIMARY EXAMINER